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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,733	04/16/2004	Masataka Shinoda	075834.00485	1364

33448 7590 10/25/2006

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EXAMINER

GOMA, TAWFIK A

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,733	<b>Applicant(s)</b> SHINODA, MASATAKA	
	<b>Examiner</b> Tawfik Goma	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

This action is in response to the amendment filed on 8/9/2006.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight et al (US 6243350) in view of Okubo (US 2003/0118936).

Regarding claim 1, Knight discloses an optical recording medium recorded and reproduced with irradiation of light thereon, said irradiation of light being made by an objective lens of which numerical aperture is larger than 1 to record and reproduce recorded pits (col. 9 lines 49-63), comprising at least a silicon layer and a silicon oxide layer being formed from the light irradiation side, in that order (fig. 31, col. 29 lines 44-67 thru col. 30 lines 1-8 and col. 34 lines 47-50). Knight discloses that a dielectric layer (3004) which can be silicon dioxide per another embodiment is formed underneath a recording layer. Knight further discloses wherein said silicon layer has formed thereon a protective layer of which refractive index is larger than a numerical aperture of said objective lens (3001, fig. 31, col. 46 lines 47-49 and col. 34 lines 45-47). Although Knight discloses that the any write-once, or phase change material can be used

as the recording layer, he fails to disclose a silicon recording layer. In the same field of endeavor, Okubo discloses a recording medium with a silicon recording layer (par. 83). It would have been obvious to one of ordinary skill in the art to use a silicon recording layer as taught by Okubo in the recording medium taught by Knight. The rationale is as follows: One of ordinary skill in the art would have been motivated to use a silicon recording layer as a suitable write-once recording material since Knight (col. 29 lines 44-67) suggests using any suitable write-once recording material and Okubo teaches that silicon is a suitable write-once material.

Regarding claim 2, Knight in view of Okubo disclose everything claimed as applied above. Further in regard to claim 2, it is known that silicon is oxidized when irradiated by a recording laser, and pits are formed by changing silicon to silicon-oxide by the recording laser. .

Regarding claim 5, claim 5 is rejected for the same reasons as claims 1 and 2 above.

Regarding claims 6 and 7, Okubo discloses using a protective layer (5, fig. 4) made of Ta<sub>2</sub>O<sub>5</sub> (par. 85). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the recording medium disclosed by Knight by substituting a protective layer made of Ta<sub>2</sub>O<sub>5</sub> as taught by Okubo. The rationale is as follows: One of ordinary skill in the art at the time of the applicant's invention would have been motivated to provide a protective layer made of Ta<sub>2</sub>O<sub>5</sub> as a well known protective layer material commonly used in the art. The refractive index of Ta<sub>2</sub>O<sub>5</sub> is known to be greater than 2 for wavelengths used during recording which would be greater than the numerical aperture of the objective lens used by Knight.

***Response to Arguments***

Applicant's arguments filed 8/9/2006 have been fully considered but they are not persuasive. Applicant's arguments are not persuasive because Knight discloses using a protective layer of Silicon Nitride over a phase change recording material whose refractive index is between 1.4 and 2 (3001, fig. 1 and col. 34 lines 45-47) and an objective lens whose numerical aperture is greater than unity (col. 9 lines 49-63). Knight further discloses wherein the phase change recording material is nearest to the light irradiation side in order to gain a near-field configuration (fig. 1). Okubo discloses wherein a phase change recording material can be silicon (col. 29 lines 44-67). The combination of Knight and Okubo disclose everything and the combination is obvious for the reasons provided above. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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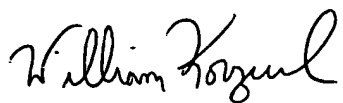
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tawfik Goma whose telephone number is (571) 272-4206. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
T. Goma  
10/18/2006

  
WILLIAM KORZUCH  
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TECHNOLOGY CENTER 2600